

# Notice of Allowability

Application No.

10/772,912

Examiner

Marc S. Zimmer

Applicant(s)

DESAI ET AL.

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## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 02/05/04.
2. ☒ The allowed claim(s) is/are 21 and 22.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 8/2/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William Uhl on September 15, 2004.

The application has been amended as follows:

In the first sentence of the Specification, please replace the period with

-- now U.S. Patent # 6,749,939. --

In claim 21 concerning the description of component (c), please substitute

-- having functional groups reactive with the functional groups of --

for the phrase "adapted to react with".

The Examiner advised Applicant that the phrase in quotes above was problematic because it connoted some change in the curing agent that left it able to react with the polyepoxide when, in fact, the curing agent is simply selected judiciously for its reactivity towards the polyepoxide. It was recommended that Applicant employ language analogous to that used to describe the curing agent set forth in claim 22.

### ***Allowable Subject Matter***

Applicant claims a composite article comprising a substrate, weldable primer layer, and a topcoat of defined constitution. The Examiner's efforts to determine the patentability of the instant invention centered around discovery of a formulation having

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the same materials as the topcoat. Cited hereinafter are the most germane documents found.

Eklund et al., U.S. patent # 6,180,726, which was cited against some claims of the parent application- this Application is a divisional of 10/078598- discloses a coating composition featuring all of the same ingredients belonging to the topcoat layer of the instant invention. However, there is no mention of a weldable primer layer nor does the prior art specifically motivate one of ordinary skill to modify the coated article aspect of Eklund's invention. Indeed, column 9, lines 57-65 state that the composition may be applied directly to a substrate without any suggestion that a primer layer would be helpful in facilitating its robust adhesion to the substrate.

Tanaka et al., U.S. patent # 6,482,536 describes a corrosion-resistant coating composition having materials corresponding to (a), (b), and (c) of the instant invention as its main film-forming components (column 2, lines 8-15). The other essential ingredient of their invention is particulate silica that, according to column 10, lines 26-35, has an oil absorption measured at 30-200 ml/100 g and an average particle diameter of 0.5 to 15  $\mu\text{m}$ . To reiterate, both of the aforementioned properties are those of a single ingredient in the composition taught by *Tanaka*. By contrast, the filler particles having an oil absorption of less than 70 are required to be different from those having a particle size of between 0.5 and 200 microns in the claimed invention. (This is not to say that the particles (d) may not have an average particle size in the aforementioned range. Indeed, claim 1 merely stipulates that there must be an additional filler (e) other than (d) that meets said particle size requirements.) Insofar as *Tanaka* does not contemplate

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adding a filler besides silica that adheres to the stated particle size limitation, the document is invalid as a reference. It is also notable that oil absorption is measured using a different technique hence it cannot be discerned whether or not this aspect of the claimed invention is truly anticipated.

Kitamura et al., U.S. patent # 4,883,717 discloses a vibration damping composition comprising (a), (b), and (c) of the instant invention as well as several fillers that, according to Applicant's Specification, fulfill the role of an inorganic particle having an oil absorption value below 70 including any of calcium carbonate, talc and mica. There is not, however, any suggestion of adding more than one type of filler let alone a restriction on the particle size of a second filler.

Japanese publication no. 56-47446 A discloses a thermoplastic polyester composition containing, in addition to the polyester, a polyfunctional epoxy compound, a polycarboxylic acid (which one of ordinary skill will appreciate is capable of crosslinking the epoxy compound), and a filler such as mica. As with *Kitamura et al.*, the addition of two or more filler materials is not indicated.

As an aside, the patent literature is rich with teachings of systems comprising a polyepoxide and a polyester. However, in most instances, these materials were selected to react with one another as a thermosetting composition. By contrast, the polyester of the instant invention, is immiscible with the polyepoxide (page 8 of the Specification) and is, hence, unreactive with said epoxide. This, according to Applicant is reflected in their characterization of said polyester as a thermoplastic.

The above references represent the most relevant prior art known. Inasmuch as they do not even render obvious the instant invention, claims 21 and 22 are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 15, 2004